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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-------------------------|------------------|
| 10/099,931 | 03/14/2002 | Oliver Bremer | 944-004.002/NC 16334 US | 2705 |
| 4955 | 7590 | 10/11/2007 | EXAMINER | |
| WARE FRESSOLA VAN DER SLUYS & ADOLPHSON, LLP BRADFORD GREEN, BUILDING 5 755 MAIN STREET, P O BOX 224 MONROE, CT 06468 | | | HENNING, MATTHEW T | |
| | | ART UNIT | | PAPER NUMBER |
| | | 2131 | | |
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| | | 10/11/2007 | | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/099,931 | BREMER, OLIVER | |
| | Examiner | Art Unit | |
| | Matthew T. Henning | 2131 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 02 August 2007.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,3-8,10-15,17-22 and 24-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,3-8,10-15,17-22 and 24-34 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 17 June 2002 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application
- 6) Other: _____.

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1 This action is in response to the communication filed on 8/2/2007.

2 **DETAILED ACTION**

3 *Response to Arguments*

4 Applicant's arguments filed 8/2/2007 have been fully considered but they are not
5 persuasive.

6 Regarding applicants' argument that Safadi requires personalization assistance from the
7 network infrastructure to encrypt protected content or content encryption key, the examiner does
8 not find the argument persuasive. In response to applicant's argument that the references fail to
9 show certain features of applicant's invention, it is noted that the features upon which applicant
10 relies (i.e., encrypting...without assistance from the network infrastructure) are not recited in the
11 rejected claim(s). Although the claims are interpreted in light of the specification, limitations
12 from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26
13 USPQ2d 1057 (Fed. Cir. 1993). In this case, the claims recite that the recipient of the content
14 consumes the content without assistance from the network infrastructure, but does not require
15 encryption without assistance. As such, the examiner does not find the argument persuasive.

16 Regarding applicants' argument that claim 1 is not limited to the content personalization
17 assistance being between the wireless sender and the network, or the wireless recipient and the
18 network, the examiner does not find the argument persuasive. First, claim 1 only refers
19 specifically to the wireless network infrastructure, and not all networks in general. The headend
20 of Safadi is not part of the wireless network infrastructure PAN 20. Second, the claim recites
21 very specifically that the consumption is what is unassisted (i.e. the recipient does not require
22 assistance from the wireless network infrastructure to playback the content), and as disclosed by

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1 Safadi, the “receiver/playback device (30) will either store the content for later use or decrypt the
2 content for playback”, and nowhere does it state that the device (30) requires assistance or
3 receives assistance from the wireless network in order to perform playback of the content. As
4 such, the examiner does not find the argument persuasive.

5 Regarding applicants’ argument that PVR 10 of Safadi interacts with the headend, and

6 therefore there must be assistance from the headend, the examiner does not find the argument
7 persuasive. In response to applicant’s argument that the references fail to show certain features
8 of applicant’s invention, it is noted that the features upon which applicant relies (i.e., the wireless
9 sender not interacting with the network infrastructure) are not recited in the rejected claim(s).

10 Although the claims are interpreted in light of the specification, limitations from the specification
11 are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir.
12 1993). Furthermore, the headend is not part of the wireless network infrastructure PAN 20, and
13 therefore the “assistance” is not from the network infrastructure 20. Further still, once the
14 recipient has been approved by the headend, the content is encrypted by the PVR, using the
15 public key of the recipient. This is the content personalization of Safadi, and there is nothing in
16 Safadi that suggests that this encryption requires assistance or is assisted by the wireless network
17 infrastructure. As such, the examiner does not find the argument persuasive.

18 Regarding applicants’ argument that PVR 10 in communication with “a system operator”
19 falls within the scope of content personalization assistance from the wireless network
20 infrastructure, the examiner does not find the argument persuasive. Nowhere in Safadi is it
21 disclosed that “a system operator” is located within the wireless network infrastructure PAN 20.
22 As such the examiner does not find the argument persuasive.

1 The examiner further notes that “determining approval” does not fall within the scope of
2 content personalization. Whether approval is granted or not has no affect on the content as the
3 content remains the same. Rather, as supported by the instant specification, the content is
4 personalized when it is encrypted by the key of the recipient.

5 The examiner notes that this response was neither fully responsive, nor compliant with 37
6 CFR 1.121. The applicants has not pointed out how claim 22, or its children, differentiates from
7 the prior art. The examiner therefore assumes that the applicants agree that claims 22-26, and
8 33, are unpatentable in view of the relied upon prior art. Further, claims 3 and 24 are labeled as
9 “Currently Amended”, but have no markings indicating any changes to the claims, and the
10 examiner does not believe that these two claims have actually been amended. In the interest of
11 expediting prosecution, the examiner has acted on the claims.

12 All objections and rejections not set forth below have been withdrawn.

13 Claims 1, 3-8, 10-15, 17-22 and 24-34 have been examined.

15 *Claim Rejections - 35 USC § 102*

16 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the
17 basis for the rejections under this section made in this Office action:

18 *A person shall be entitled to a patent unless –*

19 (e) the invention was described in (1) an application for patent, published under section
20 122(b), by another filed in the United States before the invention by the applicant for patent or
21 (2) a patent granted on an application for patent by another filed in the United States before the
22 invention by the applicant for patent, except that an international application filed under the
23 treaty defined in section 351(a) shall have the effects for purposes of this subsection of an
24 application filed in the United States only if the international application designated the United
25 States and was published under Article 21(2) of such treaty in the English language.
26

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1 Claims 1-4, 6-11, 13-17, 19-21, 27-32, and 34 are rejected under 35 U.S.C. 102(e) as

2 being anticipated by Safadi et al. (US Patent Application Publication Number 2002/0147686)

3 hereinafter referred to as Safadi.

4 Regarding claims 1 and 28, Safadi disclosed a method comprising: forwarding peer-to-

5 peer content in a wireless network having a network infrastructure (20), where a wireless sender

6 (10) encrypts protected content or content encryption key and a wireless recipient (30) consumes

7 the protected content without requiring content personalization assistance from the network

8 infrastructure (See Safadi Paragraphs 0032, 0036-0037, 0042, and 0044).

9 Regarding claim 8, Safadi disclosed a wireless network comprising: at least two wireless

10 terminals (10 and 30) and a network infrastructure (20) for forwarding peer-to-peer content from

11 one wireless terminal (10) to another wireless terminal (30); the at least two wireless terminals

12 having a peer-to-peer forwarding/reception of DRM protected content module configured for

13 either encrypting or consuming protected content without content personalization assistance

14 from the network infrastructure (See Safadi Paragraphs 0032, 0036-0037, and 0044).

15 Regarding claim 15, Safadi disclosed a wireless terminal comprising: one or more

16 modules for operating in a wireless network having another wireless terminal and a network

17 infrastructure (20) for forwarding peer-to-peer content from the wireless terminal (10) to the

18 other wireless terminal (30), each wireless terminal having a peer-to-peer forwarding/reception

19 of DRM protected content module configured for either encrypting, consuming, or a combination

20 thereof, protected content without content personalization assistance from the network

21 infrastructure (See Safadi Paragraphs 0032, 0036-0037, 0042 and 0044).

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1 Regarding claim 3, Safadi disclosed that the wireless recipient sends a device certificate
2 having a public key to the wireless sender (See Safadi Paragraphs 0036 and 0041).

3 Regarding claims 4, 11, 17, and 34, Safadi disclosed that that the wireless sender
4 personalizes the protected content or content encryption key for the wireless recipient (See
5 Safadi Paragraphs 0036-0037 and 0044).

6 Regarding claims 6, 13, and 20, Safadi disclosed that the wireless recipient verifies
7 forwarded protected content received from the wireless sender by: verifying the device certificate
8 of the wireless sender (See Safadi Paragraph 0043); and applying a private key of the wireless
9 recipient in order for the recipient to consume the protected content (See Safadi Paragraphs
10 0036-0037 and 0044).

11 Regarding claims 7, 14, and 21, Safadi disclosed that the protected content is digital
12 rights management protected content (See Safadi Paragraph 0034).

13 Regarding claims 10, and 19, Safadi disclosed that the peer-to-peer forwarding/reception
14 of DRM protected content module of a wireless sender sends a device certificate having a public
15 key to the wireless sender (See Safadi Paragraphs 0036-0037 and 0042).

16 Regarding claim 27, Safadi disclosed that the initial message includes a device certificate
17 to the wireless recipient (See Safadi Paragraph 0042).

18 Regarding claims 29-32, Safadi disclosed that the peer-to-peer forwarding/reception of
19 DRM protected content protocol module of a wireless sender sends an initial message having
20 either an international mobile equipment identity, a sender name or mobile station international
21 Integrated subscriber digital network number to a wireless recipient (See Safadi Paragraph
22 0036).

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2 ***Claim Rejections - 35 USC § 103***

3 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
4 obviousness rejections set forth in this Office action:

5 *A patent may not be obtained though the invention is not identically disclosed or
6 described as set forth in section 102 of this title, if the differences between the subject matter
7 sought to be patented and the prior art are such that the subject matter as a whole would have
8 been obvious at the time the invention was made to a person having ordinary skill in the art to
9 which said subject matter pertains. Patentability shall not be negated by the manner in which
10 the invention was made.*

11

12 Claims 5, 12, 18, 22, 26, and 33 are rejected under 35 U.S.C. 103(a) as being
13 unpatentable over Safadi as applied to claims 4, 8, and 17 respectively above, and further in view
14 of Mott et al. (US Patent Number 6,170,060) hereinafter referred to as Mott.

15 Safadi disclosed that the steps for personalizing include: encrypting the content or content
16 encryption key using a public key of the wireless recipient (See Safadi Paragraphs 0036-0037);
17 and sending the protected content or content encryption key and a device certificate of the
18 wireless sender to the wireless recipient (See Safadi Paragraphs 0042 and 0044), but failed to
19 disclose signing encrypted content or content encryption key using a private key of the wireless
20 sender, or sending the protected content with a device certificate of the sender.

21 Mott teaches that a digital signature should be appended to downloaded content in order
22 to be able to verify the data (See Mott Col. 11 Paragraph 2).

23 It would have been obvious to the ordinary person skilled in the art at the time of
24 invention to employ the teachings of Mott in the content distribution system of Safadi by
25 including a signature of the content with the content. This would have been obvious because the

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1 ordinary person skilled in the art would have been motivated to provide a means for the recipient
2 to verify the integrity of the data. Further, it was well known in the art at the time of invention
3 that the certificate of a signor could be included with the signed object and therefore it would
4 have been obvious to the ordinary person skilled in the art to have done so.

5 Regarding claim 22, the combination of Safadi and Mott disclosed a method comprising:
6 forwarding a protected content or content encryption key from a first terminal to a second
7 terminal, comprising the steps of: sending an initial message from the first terminal to the second
8 terminal (See Safadi Paragraph 0042) the initial message including a sender name, an
9 international mobile equipment identity, a mobile station integrated service digital network
10 number, or a combination thereof (See Safadi Paragraphs 0036 and 0042); sending a digital
11 rights management device certificate containing a public digital rights management key from the
12 second terminal to the first terminal (See Safadi Paragraph 0041); verifying the public digital
13 rights management key by the first terminal (See Safadi Paragraph 0041); personalizing digital
14 rights management content or content encryption key by encryption using a public key of the
15 second terminal (See Safadi Paragraphs 0036-0037 and 0044); signing encrypted digital rights
16 management content or content encryption key using a private digital rights management key of
17 the first terminal (See the rejection of claim 5 above); sending encrypted and signed digital rights
18 management content or content encryption key together with a digital rights management device
19 certificate of the first terminal from the first terminal to the second terminal (See the rejection of
20 claim 5 above); verifying the digital rights management device certificate of the first terminal by
21 the second terminal (See Safadi Paragraph 0043); and applying a private digital rights
22 management key of the second terminal, if the private digital rights management key of the first

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1 terminal is verified, in order for the second terminal to consume the protected content (See
2 Safadi Paragraph 0044).

3 Regarding claim 26, see Safadi Paragraph 0042.

4 Regarding claim 33, see the rejection of claims 29-32 above.

5 Claims 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over the
6 combination of Safadi and Mott as applied to claim 23 above, and further in view of Gustafsson
7 (US Patent Number 6,424,841).

8 Safadi and Mott disclosed sending encrypted and signed digital rights management
9 content to the first terminal and verifying the same in the first terminal (See the rejection of
10 claim 22 above), but failed to disclose sending confirmation or error messages. However, Safadi
11 and Mott did disclose that the communications were with a cell phone (See Safadi Paragraph
12 0033).

13 Gustafsson teaches that in a mobile phone system, acknowledgment messages should be
14 provided to the sender of a message by the recipient (See Gustafsson Col. 2 Paragraphs 3-4).

15 It would have been obvious to the ordinary person skilled in the art at the time of
16 invention to employ the teachings of Gustafsson in the content distribution system of Safadi and
17 Mott by having the receiver either acknowledge proper receipt of the content or send an error
18 message to the sender. This would have been obvious because the ordinary person skilled in the
19 art would have been motivated to ensure proper receipt of the content.

20 ***Conclusion***

21 Claims 1, 3-8, 10-15, 17-22, and 24-34 have been rejected.

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1 Applicant's amendment necessitated the new ground(s) of rejection presented in this
2 Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).
3 Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

4 A shortened statutory period for reply to this final action is set to expire THREE
5 MONTHS from the mailing date of this action. In the event a first reply is filed within TWO
6 MONTHS of the mailing date of this final action and the advisory action is not mailed until after
7 the end of the THREE-MONTH shortened statutory period, then the shortened statutory period
8 will expire on the date the advisory action is mailed, and any extension fee pursuant to 37
9 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,
10 however, will the statutory period for reply expire later than SIX MONTHS from the date of this
11 final action.

12 A shortened statutory period for reply to this final action is set to expire THREE
13 MONTHS from the mailing date of this action. In the event a first reply is filed within TWO
14 MONTHS of the mailing date of this final action and the advisory action is not mailed until after
15 the end of the THREE-MONTH shortened statutory period, then the shortened statutory period
16 will expire on the date the advisory action is mailed, and any extension fee pursuant to 37
17 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,
18 however, will the statutory period for reply expire later than SIX MONTHS from the mailing
19 date of this final action.

20 Any inquiry concerning this communication or earlier communications from the
21 examiner should be directed to Matthew T. Henning whose telephone number is (571) 272-3790.
22 The examiner can normally be reached on M-F 8-4.

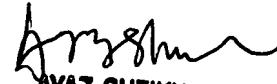
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1 If attempts to reach the examiner by telephone are unsuccessful, the examiner's
2 supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the
3 organization where this application or proceeding is assigned is 571-273-8300.

4 Information regarding the status of an application may be obtained from the Patent
5 Application Information Retrieval (PAIR) system. Status information for published applications
6 may be obtained from either Private PAIR or Public PAIR. Status information for unpublished
7 applications is available through Private PAIR only. For more information about the PAIR
8 system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR
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10 like assistance from a USPTO Customer Service Representative or access to the automated
11 information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

12
13

14 /Matthew Henning/
15 Assistant Examiner
16 Art Unit 2131
17 10/3/2007


AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100